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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,817	06/07/2001	Elliot M. Gold	41022/FLC/G322	1209

23363 7590 07/27/2005

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,817

Applicant(s)

GOLD ET AL.

Examiner

Kenneth R. Coulter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 5 and 11 – 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Catona (U.S. Pat. No. 6,288,319) Electronic Greeting Card with a Custom Audio Mix).

2.1 Regarding claim 1, Catona discloses a method of sending a song dedication from a sender to a recipient, comprising the steps of:

receiving transaction information from the sender, the transaction information comprising a recipient address, a song selection, and a voice dedication message (Abstract; Figs. 3, 6; col. 3, lines 20 – 35; col. 4, lines 20 - 35);

generating a personal identification number corresponding to the transaction information (col. 3, lines 41 – 50; col. 4, lines 41 - 46);

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transmitting the personal identification number to the recipient at the recipient address (col. 3, lines 41 – 50; col. 4, lines 41 – 46 “an electronic mail message would be sent to the recipient containing a Uniform Resource Locator (URL)”);

receiving a request from the recipient, the request including the personal identification number (col. 3, lines 41 – 50; col. 4, lines 41 – 46 “permitting the recipient to directly access his or her card.”);

transmitting the voice dedication message and the song selection to the recipient at the recipient address (Abstract; Figs. 3, 5; col. 2, lines 7 – 20).

2.2 Per claim 2, Catona teaches the method of claim 1 wherein the transmitting of the voice dedication message and the song selection to the recipient is performed using the Internet (col. 1, lines 41 – 59 “The present invention is designed with a client/server architecture, such as that commonly used for transmitting World Wide Web pages over the **Internet**.”).

2.3 Regarding claim 3, Catona discloses the method of claim 1 wherein the step of sending the voice dedication message and the song selection to the recipient is performed telephonically (col. 1, lines 41 - 59).

2.4 Per claim 4, Catona teaches the method of claim 1 wherein the transaction information further comprises a sender address, the method further comprising the step of transmitting a confirmation to the sender at the sender address after the recipient has

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been sent the voice dedication message and the song selection (col. 3, lines 41 – 50; col. 4, lines 41 – 46).

2.5 Regarding claim 5, Catona does not explicitly disclose the method of claim 1 further comprising the steps of receiving from the sender a telephone message for use as the voice dedication message.

Catona does disclose capturing the custom audio data at the client 102 (Fig. 5; col. 4, lines 1 – 20).

However, the voice dedication message can be captured in a variety of well-known methods, including remotely, by telephone.

2.6 Per claims 11 – 23, the rejection of claims 1 – 5 under 35 USC 102(e) (paragraphs 2.1 – 2.5 above) applies fully.

2.7 Regarding claim 24, Catona discloses the method of claim 1, wherein the song selection is transmitted to only the recipient identified via the recipient address in the received transaction information from the sender (Abstract; Figs. 3, 6).

Response to Arguments

3. Applicant's arguments with respect to claims 1 – 5 and 11 - 24 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

4. Claims 6 – 10 are allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER
PRIMARY EXAMINER
